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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,288	06/27/2001	Kayo Teramoto	040894-5683	1847
9629	7590	06/10/2004		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER AGUSTIN, PETER VINCENT	
			ART UNIT 2652	PAPER NUMBER 8
DATE MAILED: 06/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/891,288

Applicant(s)

TERAMOTO, KAYO

Examiner

Peter Vincent Agustin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,6 and 9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see pages 7-9, filed May 27, 2004, with respect to the rejection(s) of claim(s) 1-10 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Park et al. (hereafter Park) (US 5,608,534).

On pages 7-9 of the amendment, the applicant argues that Yonemitsu et al. (hereafter Yonemitsu) (US 5,903,705) does not show the feature of control means which outputs and displays the recording medium side reproduction restriction information as a region code when reproduction is stopped, and that Kurano et al. (hereafter Kurano) (US 5,813,010) fails to overcome the deficiencies of Yonemitsu. The argument is based on the grounds that Kurano merely displays characters on the monitor indicating that parental control is being performed, i.e., an error message is displayed, but that the user is not informed of any additional information, e.g. restriction information. The examiner agrees that Kurano, in fact, does not disclose the feature of displaying restriction information. However, as noted in the new rejection below, the missing feature would have been obvious to one of ordinary skill in the art at the time of invention by the applicant in view of Park. Therefore, the claims remain rejected and the invention is considered unpatentable.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informality:

On line 2, "comprising;" should be --comprising:--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 6 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemitsu in view of Kurano & Park.

In regard to claims 1 & 3, Yonemitsu discloses a recording medium reproduction apparatus (figure 2) for reproducing a recording medium (20) in which recorded data and recording medium side reproduction restriction information for restricting reproduction of the recorded data is recorded (column 6, lines 14-21), said recording medium reproduction apparatus comprising: recording means/member in which apparatus side reproduction restriction information related to recording medium side reproduction restriction information is recorded (column 5, lines 45-51); information reading means/member which reads the apparatus side reproduction restriction information recorded in said recording means/member (figure 5, step S102) and also reads the recording medium side reproduction restriction information from the recording medium (S101) before reproducing the recorded data from the recording medium; comparing means/member (S102) which compares the apparatus side reproduction restriction information with the recording medium side reproduction restriction information each read from said information reading means/member; determination means/member which determines whether reproduction of the recorded data is to be allowed (S104) or not (S105) based on the comparison result of said comparing means/member; control means/member which stops

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reproduction of the recorded data (S105) when said determination means/member determines that the reproduction of the recorded data is not allowed; and a reproducing means/member (figure 5, step S104), wherein the recording medium side reproduction information is a region code (figure 3B: territory code). However, Yonemitsu does not disclose that the control means/member outputs and displays the recording medium side reproduction restriction information when said determination means/member determines that the reproduction of the recorded data is not allowed. Yonemitsu also does not disclose an OSD generating means/member; and a displaying means/member, wherein when said determination means/member determines that the reproduction of the recorded data is not allowed, said control means/member generates character signal related to an error signal and a recording medium side reproducing restriction information in said OSD generating means/member, and outputs and displays on said displaying means/member with superposing on a video signal.

Park discloses an OSD generating means/member (figure 6, element 310); and a displaying means/member (column 10, line 63), a character signal related to a recording medium side reproducing restriction information is generated (column 10, lines 61-64) in said OSD generating means/member, and outputs and displays on said displaying means/member with superposing on a video signal, so that the restriction information can be recognized by the user. Kurano discloses a monitor (figure 1, element 6) that displays characters indicating that parental control is being performed (figure 30, step S30), i.e., a character signal related to an error signal, in order to notify the user that reproduction is restricted. It would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have displayed the restriction information of Yonemitsu using the OSD generating means/member and displaying

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means/member of Park, so that the restriction information can be recognized by the user.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have configured the control means/member of Yonemitsu to output and display restriction information when it is determined that reproduction is not allowed, as suggested by Kurano. The motivation would have been to notify the user that reproduction is restricted.

In regard to claims 6 & 9, Kurano, and hence the obvious combination noted above, discloses a receiving means/member (figure 1, element 6) coupled to the outside of said recording medium reproduction apparatus (as shown in figure 1), wherein when said determination means/member determines that the reproduction of the recorded data is not allowed, said control means/member outputs and displays information on said receiving means/member and on said displaying means/member (column 23, lines 13-22).


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is (703) 305-8980. The examiner can normally be reached on Monday thru Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PVA  
06/03/2004



W. R. YOUNG  
PRIMARY EXAMINER